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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/337,330	06/21/1999	JUHA MATTI PIRKOLA	017.37288X00	8862

43829 7590 05/05/2006

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EXAMINER

GELIN, JEAN ALLAND

ART UNIT PAPER NUMBER

2617

DATE MAILED: 05/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/337,330

Applicant(s)

PIRKOLA ET AL.

Examiner

Jean A. Gelin

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4,7,8 and 10-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7,8 and 13-18 is/are allowed.
- 6) ☒ Claim(s) 4, 10-12, 19, 20, 22-25, 29-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This is response to the Applicant's request over the telephone on February 02, 2006 in which claims 4, 7-8, and 10-13 have been amended and claims 1-3, 5, 6, and 9 have been canceled. Claims 1, 7, 8, and 10-32 are currently pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 10, 12, 19, 20, 22, 23, 25, and 29-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Egan et al. (US Pat. No. 6,560,223).

Regarding claims 10, 12, Egan teaches a method of call delivery to a packet-switched telephony subscriber that is roaming within a packet-switched telephony network (i.e., portable terminal using VoIP can roam from a home coverage to a remote coverage, col. 1, lines 22-65, col. 2, lines 25-35) comprising: receiving a packet-switched telephony call at a packet-switched telephony home function from a calling entity (col. 2, lines 42-53), the call including a subscriber identification identifying the called subscriber (typically, a call includes the identification of the caller and/or callee); the home function identifying subscriber location information including a packet-

Art Unit: 2617

switched telephony network address of a visited function corresponding to the subscriber identification (col. 5, line 1 to col. 6, line 11); the home function providing the address of the visited function to the calling entity (col. 5, line 1 to col. 6, line 11); establishing a packet-switched telephony call from the calling entity towards the address of the visited function (col. 5, line 54 to col. 6, line 11); forwarding the call from the serving visited function to a subscriber terminal (col. 5, lines 10-42); including the step of forwarding the call as a packet switched telephony call to the called subscriber (col. 5, line 10 to col. 6, line 40).

Regarding claim 22, Egan teaches forwarding the call from the serving visited function to a subscriber terminal (col. 5, lines 10-42).

Regarding claim 23, Egan teaches forwarding the call from the visited function to the called subscriber includes the step of forwarding the call as a packet switched telephony call to the called subscriber (col. 7, line 61 to col. 8, line 9).

Regarding claim 25, Egan teaches the remote system (i.e., visited function) is provided on the called subscriber terminal (col. 6, lines 41-67).

Regarding claim 19, Egan teaches a method of call delivery within a mobile Packet-switched telephony network comprising: receiving a local call at a gateway function, the call including a subscriber identification of the called subscriber (i.e. incoming call includes relevant information to set up a call, col. 6, lines 11-58); the gateway function obtaining from the subscriber's packet-switched telephony home function subscriber location information for the called subscriber, the subscriber location information including an address of a visited function corresponding to the subscriber

Art Unit: 2617

identification (col. 7, line 52 to col. 8, line 36); and establishing a packet-switched telephony call from the gateway function towards the address of the visited function (col. 8, lines 11-41).

Regarding claim 20, Egan teaches sending an address request message including the called subscriber's subscriber identification from the gateway function to the called subscriber's home function in the packet-switched telephony network (col. 7, line 60 to col. 8, line 10); the home function identifying subscriber location information including an address of a visited function corresponding to the subscriber identification (col. 8 lines 11-36); and receiving a message at the gateway function from the subscriber's home function including the address of the visited function corresponding to the subscriber identification (col. 7, line 60 to col. 8, line 36).

Regarding claim 29, Egan teaches packet-switched telephony network that supports mobility comprising: a home function including a home function database storing current location information and a subscriber profile for one or more subscribers (i.e., database is present to collect registration and where-about of the portable terminal, col. 7, lines 11-28); and one or more visited functions, each visited function serving an area of the packet switched telephony network each visited function providing the visited function address to the home function in response to receiving a subscriber registration request, the home function storing the address of the visited function as updated subscriber location information (col. 3, line 44 to col. 4, line 15 and col. 7, line 52 to col. 8, line 35).

Regarding claim 30, Egan teaches a subscriber terminal coupled to a visited function, the subscriber terminal providing a update location message including a subscriber identification to the visited function (col. 7, lines 11-52).

Regarding claim 31, Egan teaches a subscriber terminal is coupled to the visited function via a wireline link (col. 4, lines 42-58).

Regarding claims 32, 33, Egan teaches a subscriber terminal is coupled to the visited function via a wireless link (col. 4, lines 42-58).

Regarding claim 34, Egan teaches a subscriber terminal is coupled to the visited function via a packet switched network (col. 6, line 60 to col. 7, line 9).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Egan et al. (US Pat. No. 6,560,223) in view of Alexander Jr. et al. (US Pat. No. 5,870,589).

Regarding claim 4, Egan teaches a method of allowing packet-switched telephony subscriber to roam within a packet switched telephony network (i.e., portable terminal using VoIP can roam from a home coverage to a remote coverage, col. 1, lines 22-65, col. 2, lines 25-35) comprising: sending a message from a subscriber terminal to a visited function in a packet switched telephony network, the message including a

Art Unit: 2617

subscriber identification for the subscriber (i.e., the portable terminal roams to a visited remote coverage, typically the location update processes notify the portable's home coverage, col. 2, lines 25-35); the visited function sending a message to the subscriber's packet-switched telephony network home function providing a packet-switched telephony network address of the visited function in the as updated subscriber location information and the subscriber identification (i.e., the remote site should send to home site information regarding the portable terminal for ID and the remote site for location, col. 2, lines 36-67); storing the network address of the visited function as location information for the subscriber (the home site typically stores information regarding the portable terminal and the remote site to keep track of its location, col. 3, lines).

Egan fails to teach the packet-switched telephony network address of the serving visited function comprises an Asynchronous Transfer Mode (ATM) address.

However, the preceding limitation is very well known in the art of communication as evidenced by Alexander. Alexander teaches the use of ATM protocol address to securely send packet data to correct destination (col. 8, lines 29-67). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to implement the techniques of Alexander within the system Egan in order to provide fast packet switching and support multiple concurrent connections over a single communications lines.

6. Claims 11, 24, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Egan et al. (US Pat. No. 6,560,223) in view of Kelly (US Pat. No. 6,347,085).

Regarding claims 11, 24, and 35, Egan teaches all the limitations above except the steps of translating the packet-switched telephony call received at the visited function to a format used by the subscriber terminal that is incompatible with packet-switched telephony; forwarding the translated call from the visited function to the called subscriber terminal.

However, the preceding limitations are very well known in the art of communications, as evidenced by Kelly. Kelly teaches a gateway apparatus for connecting a circuit switched communication network to a packet switched data network comprises a processor for packetizing logic configured to translate data from the circuit switched communication network into a format suitable for transmission over the packet-switched data network to a terminal (col. 4, lines 55-66). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to implement the techniques of Kelly within the system Egan in order to enable translation of a conventional telephone number from a client task on an IP-based network into a network protocol address representing a gateway.

Allowable Subject Matter

7. Claims 7, 8, 13-18 are allowed.
8. Claims 21, 26-28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

9. Applicant's arguments with respect to claims 1-35 have been considered but are moot in view of the new ground(s) of rejection.

With respect to claims 10, 12, 19, 22, 23, and 25, the Applicant argues that there is no indication in col. 8 that telephone calls in Egan are received at the gateway. However, the Examiner disagrees with the preceding argument. In col. 7, line 67 to col. 8, line 10, Egan teaches the gateway authenticates the user which is then allowed to make and receive calls in the system (correspondent to receiving calls at the gateway).

The Applicant further argues that element 55 is remote from PSTN, is signaling device, does not receive voice call, does not establish a packet-switched telephony, and element 55 is communicated via PSTN or LAN/WAN. The Examiner would like the Applicant to read cols. 5, 7, and 8, wherein IP network 60 could be wireless, the portable terminal or mobile phone can use VOIP for communication and receives IP packet over the network 60. Therefore, claim 19 is read on Egan and the rejection is maintained.

As per claim 29, the Applicant argues that Egan does not disclose a home function database for storing subscriber profiles. However, the Examiner disagrees with the preceding argument. Inherently, the home controller or the visitor controller has a database to collect information about the portable terminal when within the range of the home/visitor (i.e., registering the portable terminal with the home controller when the portable terminal is located in the home coverage area, col. 2, lines 55-67). Therefore Egan includes a home function as recited in 29-30, and the rejection is maintained.

As per claims 10 and 20, Applicant argues that the connection from the visited function to the subscriber terminal in Egan is not a packet-switched connection. However, Egan teaches packetizing voice message and sends it over the wireless IP network which can also be used for VoIP (col. 5, lines 10-42 and col. 7, lines 1-37). Therefore, the packet-switched connection is read over the system of Egan, and the rejection is maintained.

As per claim 4, the Applicant further argues that Egan must be considered as a whole, and there is no showing in the rejection of why claim 4 in Egan should be modified; and the Applicant respectfully dispute that ATM is inherently present in the reference.

In response to Applicant's, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). however, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA 1969). In this case, Egan and Alexander, Jr. are in the same field of endeavor, they both use the Internet network which is equivalent to a packet switched network (Egan, col. 1, lines 24-26) and it is known the ATM is packet-like switching according to Newton's

Art Unit: 2617

dictionary. Given that Egan teaches packet switched telephony network (inherently present in the teaching of VoIP) and Alexander teaches the operation of LAN Emulation Resolution Protocol (LE_ARP) request; in response to this request LES responds with the ATM protocol network address (besides col. 8, lines 29-67, the entire application explains the efficiency of using ATM). ATM address is inherently present in the system of Egan and Alexander as recited above. Therefore, the Examiner maintains that the network comprises an ATM address is taught by Egan in view Alexander. Therefore, the rejection is maintained.

As per claims 11, 24, and 35, the Examiner also maintains the obviousness type rejection of Egan in view of Kelly. Both references teach communication over the packet switched network. Kelly teaches a gateway apparatus for connecting a circuit switched communication network to a packet switched data network comprises a processor for packetizing logic configured to translate data from the circuit switched communication network into a format suitable for transmission over the packet-switched data network to a terminal (i.e., equivalent to make information from one network to another compatible to each other, col. 4, lines 55-66). The Examiner maintains the rejection as recited above.

In light of the above arguments, the Examiner submits that all rejections above are maintained. Should the Applicant have any questions or comments regarding the above rejections, the Applicant is respectfully requested to address them in the response of this Office Action.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean A. Gelin whose telephone number is (571) 272-7842. The examiner can normally be reached on 9:30 AM to 7:00 PM.

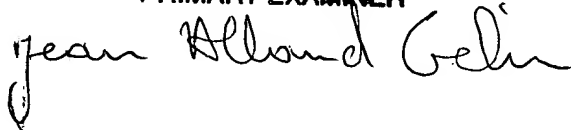
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Banks-Harold Marsha can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JGelin
April 28, 2006

JEAN GELIN
PRIMARY EXAMINER

A handwritten signature in cursive script that reads "Jean Almond Gelin". The signature is written in black ink and is positioned below the printed name and title.